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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,393	03/12/2004	Michael Naimark	INT1P206C1	7182
21912	7590	06/30/2006	EXAMINER	
VAN PELT, YI & JAMES LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO, CA 95014			ABEL JALIL, NEVEEN	
			ART UNIT	PAPER NUMBER
			2165	
DATE MAILED: 06/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,393

Applicant(s)

NAIMARK ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/28/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. The Preliminary amendment filed on 6/10/2005 has been received and entered. Claims 1-20 have been cancelled. Claims 21-53 have been newly added. Therefore, claims 21-53 are now pending.

Specification

2. The abstract of the disclosure is objected to because the abstract, line 2, recites "is disclosed" which must be deleted. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

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USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21, 40, and 47 are rejected on the ground of nonstatutory double patenting over claim 2 of Naimark et al. U. S. Patent No. 6,757,682 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claims 21, 40, and 47 of the instant application are directed to "receiving an alert...processing the alert...and notifying the participant" which is similar and arguably broader than claim 2 of patent '682 directed to "receiving an indication... processing the indication... and informing the participant".

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Objections

5. Claims 22-39, 41-46, and 48-53 are objected to because of the following informalities:

Depended claims 22-39, preamble recite “A method as recited in claim 21” which inaccurate. They need to be amended to recite “The method according to claim 21” since they are narrowing the scope of Independent claim 1 and not introduced a new device as they appear to be by reciting “A”. Correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 47 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 47 preamble recite “computer instruction **for**” is intended use and does not cause any functionality to occur in the computer since it lacks combination with hardware to realize the functionality. The limitations following the phrase “*for*” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “*for*” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney

Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”).

Claim should be amended to recite direct affirmative language such as “compromising **computer executable instruction to:** “. Instructions need to be executed in order to realize their functionality.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 21-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Eichstaedt et al. (U.S. Patent No.6,385,619 B1).

As to claims 21, 40, and 47, Eichstaedt et al. discloses a method of notifying a participant that a network accessible item is of current interest, including:

receiving an alert from an alerting entity regarding the network accessible item (See Abstract; see column 1, lines 43-55; where “real time” is read on “non-static information”);

processing the alert (See column 3, lines 20, wherein “processing” reads on “analyzing and profile generating”); and

notifying the participant that the item is of current interest (See Fig. 2, element 64; see column 1, lines 56-62; also see column 3, lines 18-20).

As to claims 22, 41, and 48, Eichstaedt et al. discloses wherein the item is identified by a Universal Resource Locator (URL) (See column 5, lines 58-60; where system works in an HTML and XML browser environment implies the topics can be identified by URL).

As to claim 23, Eichstaedt et al. discloses wherein the item includes dynamic content (See column 5, lines 58-60; where system works in an HTML and XML browser environment implies the topics can be identified by URL which is also dynamic Web content).

As to claims 24, 33, 45, and 52, Eichstaedt et al. discloses wherein the alert includes an interest category assigned by the alerting entity (See column 2, lines 42-48).

As to claims 25, 42, and 49, Eichstaedt et al. discloses wherein processing the alert includes determining an alert intensity (See column 3, lines 29-38, wherein “alerting intensity” reads on “numerical value”, also see column 3, lines 49-54)

As to claim 26, Eichstaedt et al. discloses wherein processing the alert includes determining an alert intensity based at least in part on the altering entity's identity (See Figure 2, 62, and see column 3, lines 15-20, wherein "identity" reads on "profile").

As to claims 27, 43, and 50, Eichstaedt et al. discloses wherein processing the alert includes updating a timestamp (See column 4, lines 4-10, also see column 5, lines 2-10).

As to claim 28, Eichstaedt et al. discloses further including storing data associated with the alert (See column 3, lines 7-25).

As to claim 29, Eichstaedt et al. discloses the alert includes using data associated with a previous alert (See column 4, lines 4-10, also see column 5, lines 2-10).

As to claims 30, 44, and 51, Eichstaedt et al. discloses wherein processing the alert includes determining an intensity rank (See column 3, lines 49-53; where "intensity rank" is read on "weight").

As to claim 31, Eichstaedt et al. discloses wherein processing the alert includes determining an intensity rank that decays exponentially with time (See column 4, lines 4-8).

As to claim 32, Eichstaedt et al. discloses wherein processing the alert includes:
determining an intensity rank (See column 4, lines 44-47); and

in the event the intensity rank is below a threshold, deleting data associated with the item (See column 4, lines 50-67, wherein threshold is used to calculate the relevance of the content).

As to claim 34, Eichstaedt et al. discloses wherein the participant is notified about a plurality of items of current interest and the plurality of items are selected based at least in part on an interest category associated with the participant (See column 3, lines 49-60).

As to claim 35, Eichstaedt et al. discloses wherein the participant is notified about a plurality of items of current interest and the plurality of items are selected based at least in part on intensity rank (See column 4, lines 31-47, also see column 5, lines 15-20).

As to claim 36, Eichstaedt et al. discloses wherein the participant is notified about a plurality of items of current interest and the plurality of items are ordered with respect to each other (see column 1, lines 46-55; where “intensity rank” is read on “interest score”).

As to claim 37, Eichstaedt et al. discloses wherein the participant is notified about a plurality of items of current interest and the plurality of items are selected based at least in part on a sensitivity level associated with the participant (See column 4, lines 4-28; and see column 4, lines 31-55, also see column 5, lines 2-29).

As to claims 38, 39, 46, and 53, Eichstaedt et al. discloses further including displaying to the participant content associated with the item of interest (See column 1, lines 41-44; also see column 2, lines 15-19).

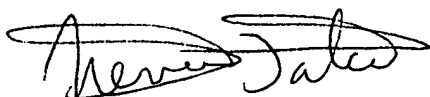
Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-Form 892 for list of Cited References.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Neveen Abel-Jalil
June 24, 2006